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HEWLETT-PACKARD COMPANY			KIM, PAUL	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MICHAEL C. ROBINSON  
and JON C. WILHEIMSEN

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Appeal 2009-005187  
Application 10/633,804  
Technology Center 2100

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Decided: May 28, 2010

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Before HOWARD B. BLANKENSHIP, CAROLYN D. THOMAS, and  
DEBRA K. STEPHENS, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-9, 11-17, and 21, which are all of the remaining claims in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

*Representative Claim*

1. A method for accessing a database of interest, the method comprising:

    a management application creating a first object for indicating a unique identifier identifying a data item, said creating said first object using a first SET command;

    an agent receiving said unique identifier from said management application and storing said unique identifier in a restricted intermediate database which is distinct from the database of interest and to which access is unavailable with the management application, wherein the agent is distinct from the restricted intermediate database and the database of interest;

    said management application creating a second object for indicating a data type for said data item, said creating said second object using a second SET command;

    said agent receiving said data type from said management application and storing said data type in said restricted intermediate database;

    said management application creating a third object for indicating an action to be performed on said data item with respect to the database of interest, said creating said third object using a third SET command;

    said agent receiving said action from said management application and issuing an action command to the database of interest to perform said action on said data item, wherein said agent uses said

stored unique identifier, said stored data type, and said action in issuing said action command; and  
said agent receiving a response to said action command from the database of interest and sending said response to said management application.

### *Prior Art*

Tsuchiya 6,950,864 B1 Sep. 27, 2005

Douglas Mauro & Kevin Schmidt, *Essential SNMP* (O'Reilly Media, Oct. 2001) ("Mauro").

### *Examiner's Rejection*

Claims 1-9, 11-17, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuchiya, Mauro, and Official Notice.

The Answer (at 3) asserts “Claim Objections” in which an amendment is apparently “objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure” However, the Answer appears later, under the same “Grounds of Rejection” heading in which the “Claim Objections” are set forth, to withdraw the “objections” (Ans. 10). We therefore conclude there are no “claim objections” before us. In any event, assuming there was an objection to the Specification under 35 U.S.C. § 132(a), the objection for new matter was not accompanied by a § 112, first paragraph rejection of the claims. Such an objection is a matter for petition, not a ground of rejection for review on appeal. *See* Manual of Patent Examining Procedure (MPEP) §§ 706.01, 1002.02(c), 1201, and 2163.06, Heading II (Eighth ed., Rev. 7, Jul. 2008). However, since the objected-to “amendment” was to the claims

rather than the written description, the proper course would have been to enter a rejection under 35 U.S.C. § 112, first paragraph against claims that contained the alleged new matter.

## ISSUE

Have Appellants shown the Examiner erred in finding that the combination of Tsuchiya, Mauro, and Official Notice teaches an agent that is “distinct from the restricted intermediate database and the database of interest” as recited in claim 1?

## FINDINGS OF FACT

1. Tsuchiya discloses a network management system for managing a managed device via, for example, a network, and more particularly to a management object process unit incorporated in the managed device as an agent. Col. 1, ll. 13-18.

2. Figure 1 shows the arrangement of the network management system. In the network management system, a host device 11, such as a computer, is connected to a managed device 13, such as a printer, via a network. Management is performed on the basis of commands transmitted and received between a manager 12 incorporated in the host device 11 and a management object process unit 14, or agent, incorporated in the managed device 13. Col. 4, ll. 7-16.

3. As shown in figure 1, the agent 14 includes a control processing section 17. Col. 4, ll. 45-48.

4. As shown in figure 3, the control processing section 17 includes an object managing section 19. Col. 4, ll. 58-60.

5. As shown in figure 4, the object managing section 19 includes a management table 20 and a table managing section 22. Col. 5, ll. 6-8.

## PRINCIPLES OF LAW

The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)). The one who bears the initial burden of presenting a *prima facie* case of unpatentability is the Examiner. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

## ANALYSIS

The Examiner finds that the database of interest recited in claim 1 corresponds to a table managing section and management table taught by Tsuchiya. The Examiner also finds that the agent taught by Tsuchiya is distinct from the table managing section and a management table. Ans. 4. However, Tsuchiya teaches that the table managing section and the management table are both part of the agent. FF 1-5.

The Examiner has failed to show that Tsuchiya teaches an agent that “is distinct from the restricted intermediate database and the database of interest” as recited in claim 1. Because neither Mauro nor the Official Notice as applied remedies the deficiencies in the rejection against claim 1, we do not sustain the § 103(a) rejection of claim 1. Independent claims 7, 15, and 21 each contain a limitation similar to that of claim 1 for which the rejection fails. We thus do not sustain the § 103(a) rejection of claims 1-9, 11-17, and 21.

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## CONCLUSION OF LAW

Appellants have shown the Examiner erred in finding that the combination of Tsuchiya, Mauro, and Official Notice teaches an agent that is “distinct from the restricted intermediate database and the database of interest” as recited in claim 1.

## DECISION

The rejection of claims 1-9, 11-17, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Tsuchiya, Mauro, and Official Notice is reversed.

REVERSED

msc

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